

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86206054
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 103
<b>MARK SECTION</b>	
<b>MARK</b>	http://tmng-al.uspto.gov/resting2/api/img/86206054/large
<b>LITERAL ELEMENT</b>	CAYENNE EXPRESS
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size color.
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>JPG FILE(S)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT 16\862\060\86206054\xml7\ RFR0002.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_1-714684162-20150726140151708065_.Cayenne_Express_Argument_For_Reconsideration_072620</a>
<b>CONVERTED PDF FILE(S) (5 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\060\86206054\xml7\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\060\86206054\xml7\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\060\86206054\xml7\RFR0005.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\060\86206054\xml7\RFR0006.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\060\86206054\xml7\RFR0007.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	logo of the mark CAYENNE without the wording EXPRESS

ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use EXPRESS apart from the mark as shown.
CONCURRENT USE	Cayenne Express, Inc.'s compliance with 15 U.S.C. § 1051: Registrant Dr. Ing.h.c. F. Porsche Aktiengesellschaft, Registration Number 389141 is the exception to Applicant's claim of exclusive use; and, ii. specifically, to the extent of the verifier's knowledge 1. there are no other concurrent users; 2. Registrant Porsche has claimed use in goods and services for classes 008, 012, 026, 034, 037, 039, and 040. Applicant's use is limited to class 039 For: Freight transport brokerage; Freight transportation brokerage; Freight transportation by truck; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; Transport and delivery of goods; Transport brokerage; Transport by land; Transport of goods; Transportation of goods; and 3. Applicant has been in actual, continuous, distinctive, uninterrupted, prior use of the mark since the 1995. Applicant is unaware of Registrant's use prior to registration date of December 21, 2010; and, 4. Applicant desires registration for services For: Freight and transport brokerage; Freight transportation brokerage; Freight transportation by truck; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; Transport and delivery of goods; Transport brokerage; Transport by land; Transport of goods; Transportation of goods; and, in the area of the contiguous United States of America.
SIGNATURE SECTION	
DECLARATION SIGNATURE	/da Christ/
SIGNATORY'S NAME	Dale A Christ
SIGNATORY'S POSITION	Attorney
SIGNATORY'S PHONE NUMBER	3174391311
DATE SIGNED	07/26/2015
RESPONSE SIGNATURE	/da Christ/
SIGNATORY'S NAME	Dale A Christ
SIGNATORY'S POSITION	Attorney
SIGNATORY'S PHONE NUMBER	3174391311
DATE SIGNED	07/26/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT	

<b>APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Sun Jul 26 14:43:15 EDT 2015
<b>TEAS STAMP</b>	USPTO/RFR-71.46.84.162-20 150726144315455568-862060 54-540da4454b0aed55894e46 45daf5112d96162f3f021136b ccc2198af0958fcea2e-N/A-N /A-20150726140151708065

PTO Form 1960 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 07/31/2017)

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **86206054** CAYENNE EXPRESS(Standard Characters, see <http://tmngal.uspto.gov/resting2/api/img/86206054/large>) has been amended as follows:

#### EVIDENCE

Evidence in the nature of logo of the mark CAYENNE without the wording EXPRESS has been attached.

#### JPG file(s):

[Evidence-1](#)

#### Original PDF file:

[evi\\_1-714684162-](#)

[20150726140151708065\\_Cayenne Express Argument For Reconsideration\\_07262015.pdf](#)

#### Converted PDF file(s) ( 5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

#### ADDITIONAL STATEMENTS

##### Disclaimer

No claim is made to the exclusive right to use EXPRESS apart from the mark as shown.

##### Concurrent use

Cayenne Express, Inc.'s compliance with 15 U.S.C. § 1051: Registrant Dr. Ing.h.c. F. Porsche Akiengesellschaft, Registration Number 389141 is the exception to Applicant's claim of exclusive use; and, ii. specifically, to the extent of the verifier's knowledge 1. there are no other concurrent users; 2.

Registrant Porsche has claimed use in goods and services for classes 008, 012, 026, 034, 037, 039, and 040. Applicant's use is limited to class 039 For: Freight and transport brokerage; Freight transportation brokerage; Freight transportation by truck; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; Transport and delivery of goods; Transport brokerage; Transport by land; Transport of goods; Transportation of goods; and 3. Applicant has been in actual, continuous, distinctive, uninterrupted, prior use of the mark since the year 1995. Applicant is unaware of Registrant's use prior to registration date of December 21, 2010; and, 4. Applicant desires registration for services For: Freight and transport brokerage; Freight transportation brokerage; Freight transportation by truck; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; Transport and delivery of goods; Transport brokerage; Transport by land; Transport of goods; Transportation of goods; and, in the area of the contiguous United States of America.

## **SIGNATURE(S)**

### **Declaration Signature**

**DECLARATION:** The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or allegation of use (AOU) unsigned, all statements in the application or AOU and this submission based on the signatory's own knowledge are true, and all statements in the application or AOU and this submission made on information and belief are believed to be true.

**STATEMENTS FOR UNSIGNED SECTION 1(a) APPLICATION/AOU:** If the applicant filed an unsigned application under 15 U.S.C. §1051(a) or AOU under 15 U.S.C. §1051(c), the signatory additionally believes that: the applicant is the owner of the mark sought to be registered; the mark is in use in commerce and was in use in commerce as of the filing date of the application or AOU on or in connection with the goods/services/collective membership organization in the application or AOU; the original specimen(s), if applicable, shows the mark in use in commerce as of the filing date of the application or AOU on or in connection with the goods/services/collective membership organization in the application or AOU; *for a collective trademark, collective service mark, collective membership mark application, or certification mark application*, the applicant is exercising legitimate control over the use of the mark in commerce and was exercising legitimate control over the use of the mark in commerce as of the filing date of the application or AOU; *for a certification mark application*, the applicant is not engaged in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant. **To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.**

**STATEMENTS FOR UNSIGNED SECTION 1(b)/SECTION 44 APPLICATION AND FOR SECTION 66(a) COLLECTIVE/CERTIFICATION MARK APPLICATION:** If the applicant filed an unsigned application under 15 U.S.C. §§ 1051(b), 1126(d), and/or 1126(e), or filed a collective/certification mark application under 15 U.S.C. §1141f(a), the signatory additionally believes that: *for a trademark or service mark application*, the applicant is entitled to use the mark in commerce

on or in connection with the goods/services specified in the application; the applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date; ***for a collective trademark, collective service mark, collective membership mark, or certification mark application***, the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date; the signatory is properly authorized to execute the declaration on behalf of the applicant; ***for a certification mark application***, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant. **To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.**

Signature: /da Christ/    Date: 07/26/2015

Signatory's Name: Dale A Christ

Signatory's Position: Attorney

Signatory's Phone Number: 3174391311

#### **Request for Reconsideration Signature**

Signature: /da Christ/    Date: 07/26/2015

Signatory's Name: Dale A Christ

Signatory's Position: Attorney

Signatory's Phone Number: 3174391311

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86206054

Internet Transmission Date: Sun Jul 26 14:43:15 EDT 2015

TEAS Stamp: USPTO/RFR-71.46.84.162-20150726144315455

568-86206054-540da4454b0aed55894e4645daf

5112d96162f3f021136bcc2198af0958fcea2e-

N/A-N/A-20150726140151708065





U.S. Trademark Application No. 86206054

**ARGUMENT IN FAVOR OF RECONSIDERATION**

Submitted July 26, 2015

**Application For Registration Based On Prior Use:**

In its Response to the Office Action dated June 23, 2014, Applicant Cayenne Express, Inc. stated the following:

“15 U.S.C. 1052 §(f) states that “[e]xcept as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, ***nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. (emphasis added herein)*** The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” CAYENNE and CAYENNE EXPRESS are common law service marks, which have become distinctive of Applicant, Cayenne Express, Inc., in connection with its services in commerce. Applicant has continuously used its common law service marks in commerce not only for the five (5) years before the date on which it filed its application for registration of its mark, but well beforehand, i.e. for not less than the eighteen (18) years prior to such filing. Cayenne Express is a nationwide trucking company, which has continuously used, without interruption, its service marks of CAYENNE EXPRESS, and CAYENNE, throughout the continental United States, including not less than 43 of the 48 contiguous states, in providing freight transportation services by truck (any states not presently served clearly fall within Applicant’s “zone of natural expansion.”) Applicant has provided and provides freight transportation services for nationwide companies in Anheuser-Busch beers, Goop brand cleaning products of Critzas Industries, Inc., appliances for Peerless Premier, and food products such as Golden Dipt brands for Kerry Ingredients. Applicant maintains documents of its service transactions for the past seven (7) years, which prove its service mark in continuous, uninterrupted use. Documents include billings, invoices, correspondence on letter head, stationery, business cards and the like. Each of Applicant’s drivers carry, present and use Bills of Lading / Freight Bills and Lumper Receipts (for loaders and unloaders of freight), all of which utilize Applicant’s marks. Applicant utilizes a fleet of 33 tractors and 100 trailers to provide its services, all of which also prominently display the service marks CAYENNE and/or CAYENNE EXPRESS. Applicant buys and provides promotional items, including gifts bearing its service marks, to

customers throughout the United States. Applicant has for years maintained a website offering its services nationwide, and displaying its service marks throughout. Applicant's president is a leader in his industry including participation in the National Association of Small Trucking Companies, American Truck Association, Illinois Truck Association, and, Mid-west Truckers Association, where he served two (2) years as Secretary, and two (2) years as President of the Southern Advisory Board, during which time his CAYENNE EXPRESS and CAYENNE service marks were regularly displayed in interstate communications involving members, which is a body of 3000 people throughout 15 states.

The foregoing unequivocally demonstrates that Applicant has not only used his service marks, but he has also invested enormous time and expense to make them distinctive among leading U.S. companies, customers, and trucking industry leaders. Therefore, Applicant requests registration of his service mark, CAYENNE EXPRESS as initially submitted, subject to the disclaimer the Office has sought and Applicant has provided."

Inasmuch as Applicant has actual, continuous, distinctive, uninterrupted, prior use of the marks Cayenne and Cayenne Express throughout the contiguous continental United States, including sales and marketing efforts in all 48, actual services in not less than 43, and a trucking company of significant size, he is the owner of the rights in the marks CAYENNE and CAYENNE EXPRESS. His ownership is acknowledged and recognized in Allard Enters. v. Advanced Programming Res., Inc., which states: "[o]wnership rights flow only from prior use--either actual or constructive. Federal registration of a trademark or service mark cannot create rights and priority over others who have previously used the mark in commerce, but federal registration is prima facie evidence of the registrant's ownership and exclusive right to use the mark, 15 U.S.C. §§ 1057(b), 1115(a), and constitutes constructive use of the mark. 4 McCarthy § 26:38 (4th ed. 2000). "Constructive use" means that which establishes a priority date with the same legal effect as the earliest actual use of a trademark at common law. 4 McCarthy § 26:38 (4th ed. 2000). In the typical case in which a senior user applies for the federal registration, "constructive use will fix a registrant's nationwide

*priority rights in a mark from the filing of its application for registration." Id. In the case in which a junior user applies for registration, however, the extent of the senior user/non-registrant's territory is frozen as of the date of actual registration to the junior user. 4*

McCarthy §§ 26:40, 25:53; Lanham Act § 15, 15 U.S.C. § 1065. Allard Enters. v. Advanced Programming Res., Inc., 249 F.3d 564, 572, 2001 U.S. App. LEXIS 8508, \*15-16, 2001 FED App. 0153P (6th Cir.), 10, 58 U.S.P.Q.2D (BNA) 1710, 1715 (6th Cir. Ohio 2001).

Consequently, Applicant is deserving of registration of his marks.

Applicant also disclaimed any exclusive right to use the word "EXPRESS," stating in his application *"Applicant, Cayenne Express, Inc., hereby disclaims the descriptive wording "EXPRESS" and employs the standardized format for disclaimer, to wit: **"No claim is made to the exclusive right to use "EXPRESS" apart from the mark as shown."**"*

In his Response, Applicant further cited 1 J. McCarthy, Trademarks and Unfair Competition § 20.14 (1973), and the court in International Order of Job's Daughters v. Lindeburg & Co., 727 F.2d 1087 (1984) which stated that "[f]or Principal Register registrations less than five years old (like that of Job's Daughters), cancellation may be based upon any ground which would have prevented registration initially." Registrant's mark was registered on December 21, 2010, less than five years from the date of Applicant's application, and "any ground" reasonably contemplates the prior user's, non-registered, senior use and application for registration, as well as statutory factors such as damage as a result of a likelihood of dilution by blurring. Therefore, the Office should cancel Registrant's mark based upon Applicant's application, notwithstanding the absence of a Petition To Cancel; and award registration to Applicant; or, permit Applicant an opportunity secure

qualified counsel for purposes of filing a Petition To Cancel. *"There is ample authority for the proposition that the right to cancellation is not limited .... Any prior use of a name or word is sufficient to warrant cancellation on the ground that the prior user is injured by such registration."* Blanchard Importing & Distributing Co. v. Societe E. Blanchard et Fils, 56 C.C.P.A. 716, 718-719, 402 F.2d 797, 799, 1968 CCPA LEXIS 245, \*5-6, 159 U.S.P.Q. (BNA) 520 (C.C.P.A. 1968), *citing* California Piece [Dye] Works v. California Hand Prints, *supra*; Bellbrook Dairies v. Hawthorn-Mellody Farms Dairy, 253 F.2d 431 (C.C.P.A. 1958); Krank v. Philippe, 295 F. 1001 (D.C. Cir. 1924); Lever Bros. Co. v. Nobio Products, 103 F.2d 917 (C.C.P.A. 1939); Bellbrook Dairies v. Bowman Dairy Co., 273 F.2d 620, 623 (C.C.P.A. 1960)."

**Concurrent Registration:**

In his Response, Applicant objected to Registrant's concurrent use of Applicant's mark. Pending Applicant's desire and/or ability to secure qualified counsel in the event of a Petition To Cancel, Applicant's mark(s) is/are, at minimum, entitled to concurrent use registration. To protect his interest in registering his mark, Applicant shall modify his application and seek registration for concurrent use with Registrant pursuant to 15 U.S.C. § 1052, without waiving any rights, including but not limited to ownership rights, rights to sole registration, rights to Petition To Cancel, and the like.

**Conclusion:**

Applicant respectfully requests the Office to Reconsider his Application, and either cancel Registrant's invalid registration of the mark CAYENNE, and to register the mark to Applicant; or, register Applicant's mark(s) for concurrent use with that of Registrant.

Respectfully submitted,

Dale A. Christ, J.D.  
Attorney for Applicant